

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH BARRACLOUGH, BRYAN R. MARTIN,
and KEVIN DEIERLING

Appeal 2007-0991
Application 08/941,975
Technology Center 2600

Decided: May 23, 2007

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP,
JEAN R. HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-5 and 7-14. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal concerns videoconferencing. Videoconferencing, which permits audio and visual communication between remotely located terminals, is becoming common in business and residential applications. (Specification 1.) One approach to videoconferencing employs a digital video camera coupled to the input port of a personal computer ("PC"), which is programmed to provide videoconferencing over a communications channel such as the Internet. The approach is useful for applications where a PC is available and its user is familiar with downloading software and using the PC to control videoconferencing. The approach is disadvantageous, however, to those who are computer illiterate or are not interested in using a computer for videoconferencing. (*Id.* 2.)

In contrast, the Appellants' videoconferencing system uses a modular terminal that includes a conventional digital still camera coupled to the input port of a "videocommunicator," such as a set top box. (*Id.* 16.) Using commercially available and relatively inexpensive components, such as the camera, a television set, and a telephone, the Appellants' videocommunicator serves as a central controller providing videoconferencing signal coordination and processing in a relatively inexpensive, modular form. (*Id.* 9.)

B. CLAIMS

Claims 1, 7, 12, and 14, which further illustrate the invention, follow.

1. A method of videoconferencing comprising the steps of:

providing a videocommunicator having a video signal input port, a video signal encoding circuit and a video signal output port; and

using a digital still camera to generate video input signals to the video input port of the videocommunicator, the video output port of the videocommunicator capable of communicatively coupling to a communications channel for providing videoconferencing.

7. An arrangement for use in a videoconferencing system, comprising:

a set-top box having a first video input port and a video output port, and first and second telephone ports, the set-top box configured and arranged to output video signals via the video output port, output local video data signals via the second telephone port, and input remote video data signals via the second telephone port, responsive to control signals at the first telephone port, the set-top box further including a video-signal processing circuit having a programmable DSP circuit adapted to compress video data and having a programmable general purpose processor circuit;

a camera coupled to the first video input port, and configured and arranged to output video signals representative of stored images of scenes captured by the camera;

a telephone circuit coupled to the first telephone port and configured and arranged to receive user control inputs and, responsive thereto, provide control signals to the set-top box; and

a monitor coupled to the video output port to receive the video signals and display images represented by the video signals.

12. A video image viewing arrangement, comprising:

a set-top box having first and second input ports, an output port, and the set-top box configured and arranged to output display signals via the output port responsive to control signals at the second input port;

an external video camera coupled to the first input port of the set-top box, configured and arranged to output video signals;

a control unit coupled to the second input port and configured and arranged to receive user control inputs and, responsive thereto, provide control signals to the set-top box; and

a display coupled to the output port of the set-top box to receive the display signals.

14. A method of videoconferencing comprising the steps of:

providing a videocommunicator having a video signal input port, a video signal output port, and a video signal encoding circuit with a programmable DSP circuit adapted to compress video data and with a programmable general purpose processor circuit;

using a digital still camera to generate video input signals to the video input port of the videocommunicator, the video output port of the videocommunicator capable of communicatively coupling to a communications channel for providing videoconferencing; and

using the videocommunicator for controllably altering a display, including at least one of pan, tilt and zoom functions, of the video input signals without controlling the digital still camera.

C. REJECTIONS

Claims 1 and 12 stand rejected under 35 U.S.C. § 102(a) as anticipated by Japanese Patent Application Pub. No. Hei 3-229588 ("Iwasaki"). Claims 2-5, 7-11, 13, and 14 stand rejected under 35 U.S.C. § 103(a) as obvious over Iwasaki and U.S. Patent No. 5,016,107 ("Sasson"). Rather than reiterate the positions of parties *in toto*, we focus on the issues therebetween.

II. § 1.131 DECLARATIONS

The Appellants make the following assertions.

The evidence of record includes two Declarations by one of the inventors and managers of a team of engineers working on the company-wide project, which project was comprehensively described over a substantial period of time to outside patent counsel for the purpose of preparing the parent patent application (now U.S. Patent No. 5,379,351) to which the instant application claims priority under 35 U.S.C. 120. The second of these Declarations (executed July 19, 2000) clearly establishes the relationship between the claimed invention of the instant application (Serial No. 941,975), the parent patent application (now U.S. Patent No. 5,379,351), and the

photocopy of the actual prototype board which was attached to each of the Declarations.

(Br.¹ 11.) The Examiner asserts that "one of ordinary skill in the art would not be able to relate the Appellant's present invention and its claims to the photocopy of the generic circuit board drawing with a microprocessor, memory, DMA and I/O ports." (Answer² 12.) Therefore, the issue is whether the Appellants' declarations suffice to establish invention before the publication date of Iwasaki.

A. SIGNATURE ON DECLARATIONS

When any claim of an application . . . is rejected under 35 U.S.C. 102(a) or (e), or 35 U.S.C. 103 based . . . on reference to a foreign patent or to a printed publication, the inventor of the subject matter of the rejected claim. . . may submit an appropriate oath or declaration to overcome the patent or publication.

37 C.F.R. § 1.131(a) (2000).³ "In the case of joint inventors, the word 'inventor' in Rule 131 means joint inventors." *Ex parte Huetter*, 62 USPQ2d 1553, 1563 (B.P.A.I. 2001). The Appellants admit, "MPEP 715 clearly sets forth the requirements for meeting the 1.131 submission. . ." (Br. 11.)

¹ We rely on and refer to the Amended Appeal Brief, in lieu of the original Appeal Brief, because the latter was defective. *Ex parte Barraclough*, No. 2004-1497, 3-4 (B.P.A.I. Mar. 16, 2005). The original Appeal Brief was not considered in deciding this appeal.

² We rely on and refer to the Examiner's Answer of July 24, 2006, in lieu of the original Examiner's Answer, because the latter was defective. *Id.* 2-3. The original Examiner's Answer was not considered in deciding this appeal.

³ We cite to the version of the Code of Federal Regulations ("C.F.R.") in effect when the second Declaration under 37 C.F.R. § 1.131 was filed.

For its part, this section of the Manual of Patent Examining Procedure ("MPEP") explains that "Affidavits or declarations to overcome a rejection of a claim or claims on a cited patent or publication must be made by the inventor or inventors of the subject matter of the rejected claim(s). . ." MPEP §715.04 (7th ed., rev. 1, Feb. 2000⁴). "[W]here all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims." *Id.* "Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient." *Id.*

Here, it is uncontested that the two Declarations under 37 C.F.R. §1.131 are signed by only "one of the inventors." (Br. 11.) The Appellants do not allege, let alone show, that Bryan R. Martin, the sole Declarant, is the sole inventor of claims 1-5 and 7-14. To the contrary, Martin admits that he is only "a joint inventor of the subject matter which is claimed. . ." (First Martin Decl. at 1; Second Martin Decl. at 1.) Furthermore, the Appellants do not allege, let alone show, that Keith Barraclough or Kevin Deierling, the other joint inventors, (Decl. under 37 C.F.R. § 1.63 at 2), are deceased, refuse to sign, or are otherwise unavailable.

⁴ We cite to the version of the MPEP in effect when the second Declaration under 37 C.F.R. § 1.131 was filed.

B. SUBSTANCE OF DECLARATIONS

"The primary consideration is whether, in addition to showing what the reference shows, the affidavit also establishes possession of either the whole invention claimed or something falling within the claim, in the sense that the claim as a whole reads on it." *In re Tanczyn*, 347 F.2d 830, 833, 146 USPQ 298, 301 (CCPA 1965). Here, we focus on four assertions in Martin's second Declaration.

First, Martin asserts, "The referenced prototype circuit board included a CPU . . . having an architecture corresponding to the vision controller 12 and vision processor 10 of Figure 1 of U.S. Patent No. 5,379,351 ('the '351 patent')." (Second Martin Decl. ¶ 2.) The meaning of the expression "corresponding to" is ambiguous. We are uncertain, for example, whether the prototype's CPU implements the vision controller and vision processor of the '351 patent.

Second, Martin asserts, "A video camera was coupled to the CPU through a 'Video I/O' circuit also as depicted in the attached photocopy. . . ." (*Id.* ¶ 3.) Although claims 8-11 recite "a video camera," claims 1, 3, 5, and 14 recite "a digital still camera." The Appellants attempt to distinguish the "'digital still camera' of claim 1 . . . as opposed to the 'built-in video camera 7'. . . ." (Reply Br. 6.) Based on this distinction, we are uncertain whether the video camera that was coupled to the CPU implements the digital still camera of claims 1, 3, 5, and 14 or only the "video camera" of claims 8-11.

Third, Martin asserts, "As depicted in the '351 patent and in the corresponding prototype, the 'CPU' decompressed received video images and used the 'Video I/O' circuit to send these decompressed images to a display." (Second Martin Decl. ¶ 5.) We are uncertain of the relevance of this assertion to claims 1-5 and 7-14.

Fourth, Martin mentions "successful testing and implementation of the above-referenced prototype circuit board." (*Id.* ¶ 6.) "The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged." MPEP § 715.07. Here, the Appellants merely conclude that testing and implementation was successful. We need details about the testing and implementation, however, to determine whether the invention was reduced to practice.

C. CONCLUSION

For the aforementioned reasons, we agree with the Examiner that Martin's declarations are insufficient to establish invention before the publication date of Iwasaki.

III. DIGITAL CAMERA

The Examiner finds that Iwasaki "teaches . . . a camera 7. . ." (Answer 5.) The Appellants allege that "examples of noncorrespondence include: 'digital still camera' of claim 1 (as supported with specified digital-image ITU-based formats (e.g., p. 6 of Specification)) as opposed to the 'built-in video camera 7' of the *Iwasaki* reference with no explanation of

implementation or formatting. . . ." (Reply Br. 6.) Therefore, the issue is whether the Appellants have distinguished the claimed camera over that of Iwasaki.

In addressing the issue, the Board conducts a two-step analysis. First, we construe the claim at issue to determine its scope. Second, we determine whether the construed claim is anticipated.

A. CLAIM CONSTRUCTION

Our analysis begins with construing the claim limitations at issue. "[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 1 recites in pertinent part the following limitations: "using a digital still camera to generate video input signals. . . ." The claim omits any mention of the "specified digital-image ITU-based formats" relied on by the Appellants. Although page six of the Specification mentions formatting "using a capability that supports the ITU-TG.711, G.723, or G.728 standard," moreover, this formatting is not for video signals generated by a camera. Instead, the formatting is for "audio data," (Specification 6), which are "received by multiplexer/data processing equipment (MDPE) 24." (*Id.*)

Furthermore, although claim 1 labels the camera as a "still" camera, the limitations define it as generating video signals. Giving claim the broadest, reasonable construction, therefore, the limitations require a camera for generating input video signals.

B. ANTICIPATION ANALYSIS

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "[A]nticipation is a question of fact." *In re Hyatt*, 211 F.3d 1367, 1371-72, 54 USPQ2d 1664, 1667 (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 L. Ed. 829 (1869); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)). "A reference anticipates a claim if it discloses the claimed invention 'such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.'" *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) (quoting *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962)).

Here, Iwasaki "pertains to a video telephone device being used by connecting with a digital line having several information channels and a signal channel for control." (Translation 3.) The Appellants admit that the video telephone device features a "'built-in video camera 7'...." (Reply Br. 6.) For its part, the reference explains, "An input image from a built-in video camera 7 is once sent into the image memory part 5 through the image

processing part 4 and sent to an encoding part 8 through the image processing part 4." (Translation 7.)

C. CONCLUSION

Because Iwasaki's video camera 7 generates input images, we agree with the Examiner that the Appellants have not distinguished their claimed camera over that of Iwasaki.

IV. VIDEO OUTPUT PORT

The Examiner makes the following findings.

Iwasaki in Drawing 1 illustrates picture processing section (4, Drawing 1) with an output line that is connected, through system control unit (2) to the line interface circuit (1) that is connected to the ISDN line (20) of Drawing 1. This clearly indicates that video processing section (4, Drawing 1) with an output line that is capable of communicatively coupling to a communication channel for providing video conferencing.

(Answer 7.) The Appellants argue that "'item 4' does not correspond to Appellant's claimed 'output port capable of communicatively coupling to a communications channel for providing videoconferencing' (e.g., claim 1)."

(Reply Br. 7.) Therefore, the issue is whether the Appellants have shown error in the Examiner's finding that Iwasaki discloses a video output port capable of communicatively coupling to a communications channel for videoconferencing.

A. CLAIM CONSTRUCTION

Claim 1 further recites in pertinent part the following limitations: "the video output port of the videocommunicator capable of communicatively

coupling to a communications channel for providing videoconferencing." Giving claim the broadest, reasonable construction, the limitations require a video output port capable of communicatively coupling to a communications channel for videoconferencing.

B. ANTICIPATION ANALYSIS

"Figure 1 is a systematic diagram showing an example of the video telephone device of [Iwasaki]." (Translation 11.) "In Figure 1, 1 is a line interface part, and it is connected to a digital line 20, and multiplexing and separating of an information channel D and channels B1 and B2 for control are carried out." (*Id.* 6.) "The information signal introduced from the line interface part 1 is sent to a system control part 2 and separated into an audio information and a video information. The system control part 2 controls all function parts, analyzes the information signal introduced, and controls each part based on the analysis result." (*Id.*)

C. CONCLUSION

Because the line interface part 1 is connected to the digital line 20 to provide a video telephone service, we agree with the Examiner's finding that the reference discloses a video output port capable of communicatively coupling to a communications channel for videoconferencing. The Appellants' aforementioned argument that "item 4" of Iwasaki does not correspond to output port of claim 1, moreover, shows no error in that finding.

V. DIGITAL SIGNAL PROCESSOR ("DSP")

The Examiner asserts that "it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Iwasaki's system to provide for DSP circuit for compression of video data. . . ."

(Answer 4-5.) He offers the following explanation.

Sassson [sic] clearly provide the motivation in that he states "that one desirable consequence of this architecture is that the processing algorithm employed in the compression and recording section may be selected for quality treatment of the image rather than for throughput speed["] (fig. 1A, col. 4 lines 60-63). . . . This clearly suggests that compression algorithm can be selected to get quality treatment of the image (desired results).

(*Id.* 11.) The Appellants argue that "no evidence has been presented that the skilled artisan would be so motivated to modify the Iwasaki reference in this alleged manner." (Reply Br. 10.) Therefore, the issue is whether the Appellants have shown error in the Examiner's reason for employing a DSP in Iwasaki.

"The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000) (citing *In re Dembiczaik*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). A reason to combine teachings from the prior art "may be found in explicit or implicit teachings within the

references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)).

Here, the Examiner's finding that Sasson teaches a DSP is uncontested. More specifically, the secondary reference employs "a digital signal processor 22, which controls the throughput processing rate for the compression and recording section 4 of the camera." (Col. 4, ll. 17-19.) Furthermore, the Examiner has found a reason to employ such a digital signal processor in Iwasaki. Specifically, Sasson explains that "[o]ne desirable consequence of [its] architecture is that the processing algorithm employed in the compression and recording section may be selected for quality treatment of the image. . ." (*Id.* ll. 60-63.)

C. CONCLUSION

We agree with the Examiner's finding that desirability of quality treatment of an image reason would have prompted a person of ordinary skill in the relevant field to employ a DSP in Iwasaki. The Appellants have not addressed, let alone shown error in, this reason.

VI. HOUSING

The Examiner finds that "it stands to reason . . . that various functional components in fig. 1 of Iwasaki including items 1-5 and 8-15 have to be housed in some form of housing which is implied." (Answer 8.)

The Appellants argue that "the Examiner has erroneously alleged that items 1-5 and 8-15 of the *Iwasaki* reference constitute a certain type of set-top box. No other information was provided, for example, teaching from the Iwasaki reference that indicates . . . whether these functional portions are even enclosed with each other inside any type of housing." (Reply Br. 7.) Therefore, the issue is whether the Appellants have shown error in the Examiner's finding that Iwasaki employs a housing for its components.

A. CLAIM CONSTRUCTION

"An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345, 65 USPQ2d 1961, 1965 (Fed.Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencel*, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed.Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

Here, independent claims 7 and 12 recite in pertinent part the following limitations: "a set-top box. . . ." Because the expression "set-top" merely states an intended placement of the "box," the expression is not entitled to patentable weight. Giving the independent claims the broadest, reasonable construction, therefore, the limitations require a housing for its components.

B. ANTICIPATION AND OBVIOUSNESS ANALYSIS

"Every patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed. . . ." *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977) (quoting *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 424 (CCPA 1973)). Those persons "must be presumed to know something" about the art "apart from what the references disclose." *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962).

Here, Figure 1 of Iwasaki shows the components of the reference's video telephone device. We agree with the Examiner's finding that persons skilled in the art would have known that the components of Iwasaki's video telephone device are contained in a housing.

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembicza*k, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l*, 127 S.Ct. at 1739, 82 USPQ2d at 1395.

Here, we take official notice that video and telephone components were known to be encased in a housing at the time of the Appellants' invention. We further take official notice of some of the advantages that a housing was known to provide. For example, the housing protected the electrical components from environmental hazards such as dust and water. Conversely, the housing protected persons from coming into electrical contact with the housed circuitry. The housing also provided a more aesthetic appearance than naked circuitry such as the printed circuit board shown in the "true and accurate photocopy," (Second Martin Decl. ¶ 1), provided by the Appellants.

C. CONCLUSION

"[A] patent need not teach, and preferably omits, what is well known in the art," *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984)). Because persons skilled in the art would have known that the components of Iwasaki's video telephone device are contained in a housing, Iwasaki's silence about the housing does not persuade us of error in the Examiner's finding. Furthermore, we conclude that enclosing the components in a housing to yield predictable results would have been obvious.

VII. TELEPHONE CIRCUIT OR CONTROL UNIT

The Examiner finds, "Drawing 1 of Iwasaki reference [shows] a control unit (2, fig. 1 of Iwasaki) which has inputs to accept control signals

from the operation part (11) and telephone (10)." (Answer 10.) The Appellants argue, "The Examiner previously defined item 4 as an input port and also as an output port." (Reply Br. 8.) Therefore, the issue is whether Appellants have shown error in the Examiner's finding that Iwasaki discloses a telephone circuit or control unit coupled to an input port to receive user control inputs and, responsive thereto, to provide control signals.

A. CLAIM CONSTRUCTION

Independent claim 7 further recites in pertinent part the following limitations: " a telephone circuit coupled to the first telephone port and configured and arranged to receive user control inputs and, responsive thereto, provide control signals to the set-top box. . ." Similarly, independent claim 12 further recites in pertinent part the following limitations: "a control unit coupled to the second input port and configured and arranged to receive user control inputs and, responsive thereto, provide control signals to the set-top box. . ." Giving the independent claims the broadest, reasonable construction, therefore, the limitations require a telephone circuit or control unit coupled to an input port to receive user control inputs and, responsive thereto, to provide control signals.

B. ANTICIPATION ANALYSIS

Iwasaki's video telephone device includes "a voice processing part 9," (Translation 7), "a transmitter-receiver 10," (*id.*), "an operation part 11," (*id.* 8), and an "operation interface part 12. . ." (*Id.*) "[I]nformation input from the operation part 11 is introduced into the system control part 2 through the

operation interface part 12, and . . . each processing part is controlled based on the input information." (*Id.*)

C. CONCLUSION

Because the operation interface part 12 receives information via its operation part 11 and, responsive thereto, provides control signals to the system control part 2, we agree with the Examiner's finding that Iwasaki discloses a telephone circuit or control unit coupled to an input port to receive user control inputs and, responsive thereto, to provide control signals. The Appellants' argument that item 4 was previously defined as an input port and also as an output port, moreover, shows no error in that finding.

VIII. ZOOM FUNCTION

The Examiner makes the following assertions.

Iwasaki's abstract . . . says the following: In a picture processing part 4, the omit processing for the picture information is executed according to a designated number of the pictures to be displayed, and picture information changed in picture size so that plural pictures can be displayed in one screen and picture thinning is supplied to the display part 6 which implies zooming without controlling the digital still camera, because it is adjusting the size of the picture size which is a form of zooming (see third and fourth paragraphs of page 4 and last paragraph of page 9 of English translation).

(Answer 9.) The Appellants argue that "the *Iwasaki* reference teaches that the 'picture thinning' function is for duplicating (or 'reproducing') pictures for display purposes, as is discussed at length in connection with item 3

(e.g., at pages 5 and 11) which the *Iwasaki* reference call 'the decoding part 3.'" (Reply Br. 9.) Therefore, the issue is whether the Examiner has shown that Iwasaki would have suggested panning, tilting, or zooming a displayed image without controlling the attached camera.

In addressing the issue, the Board conducts a two-step analysis. First, we construe the claim at issue to determine its scope. Second, we determine whether the construed claim would have been obvious.

A. CLAIM CONSTRUCTION

Claim 14 recites in pertinent part the following limitations: "using the videocommunicator for controllably altering a display, including at least one of pan, tilt and zoom functions, of the video input signals without controlling the digital still camera." Giving the claim the broadest, reasonable construction, the limitations require panning, tilting, or zooming a displayed image without controlling the attached camera.

B. OBVIOUSNESS ANALYSIS

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (B.P.A.I 2004). "In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from

the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the Examiner relies on the thinning operation of Iwasaki. Regarding this operation, the reference explains that "when 9 sheets of images are simultaneously displayed, they are thinned out by 2 dots for 3 horizontal and vertical dots in the image processing part 4, and each image is synthesized. Thus, as shown in a display example of Figure 2, 9 sheets of images are simultaneously displayed." (Translation 9.) Contrary to the Examiner's assertion, we are unpersuaded that thinning dots of an image constitutes zooming the image.

C. CONCLUSION

The Examiner does not allege, let alone show, that the addition of Sasson cures the aforementioned deficiency of Iwasaki. Absent a teaching or suggestion of panning, tilting, or zooming a displayed image without controlling the attached camera, we are unpersuaded of a *prima facie* case of obviousness regarding the panning, tilting, or zooming a displayed image without controlling the attached camera.

VIII. ORDER

For the aforementioned reasons, the rejection of claims 1 and 12 under § 102(a) is affirmed, and the rejection of claims 2-5, 7-11, and 13 under

§ 103(a) is also affirmed. The rejection of claim 14 under § 103(a), however, is reversed.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the brief(s). Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

Appeal 2007-0991
Application 08/941,975

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

pgc

CRAWFORD MAUNU PLLC
1270 NORTHLAND DRIVE, SUITE 390
ST. PAUL MN 55120